

## REMARKS

### Preliminary Remarks

After entry of this amendment, claims 1-19 will be pending in this patent application. Applicants have amended claims 1, 9 and 10, and have added new dependent claims 12-18 and new independent claim 19. This response is timely filed because the due date of February 22, 2003 was a Saturday and February 23, 2003 was a Sunday; no extensions of time are required.

### The Rejections

Claims 1-8 and 11 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by SOLTWEDEL et al., U.S. Patent No. 5,624,978, in light of the 10<sup>th</sup> Edition Merriam-Webster's Collegiate Dictionary definitions of the terms "bonding" and "plastic." Applicants note that the 10<sup>th</sup> edition of that dictionary was published after Applicants' priority date, and, therefore, it cannot be used to support a rejection. However, the Examiner's generic definitions of "plastic" and "bonding" are noted, and Applicants will respond to the merits of the rejection. Applicants respectfully traverse this rejection for at least the following reasons.

The test for anticipation is one of identity. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants submit that Soltwedel et al. does not disclose each and every element of claim 1.

Claim 1, as amended, recites "bonding a thermoplastic film directly on the second coating layer using an adhesive to form a third coating layer of the protective and decorative

laminar coating.” Applicants respectfully submit that Soltwedel et al. does not disclose at least that feature.

The Soltwedel et al. reference is primarily directed to deposition of primer and basecoat layers of a coating composition. In asserting that Soltwedel et al. discloses final coating layers, the Examiner is apparently referring to the disclosure in column 14, particularly lines 62-67, which states that:

The primer or topcoats which can be applied over the basecoat may be deposited from aqueous or solvent systems, and the primer and topcoats may or may not be weldable. Many commercially available primers and topcoat compositions are available and can be applied over the basecoat compositions of this invention.

Neither that passage nor any other in Soltwedel et al. discloses that a thermoplastic film may be bonded with an adhesive directly on a second coating layer of a laminar coating to form a third layer of the laminar coating. Instead, Soltwedel et al. actually discloses that a topcoat may be “deposited from aqueous or solvent systems.” Therefore, Applicants submit that Soltwedel et al. does not anticipate claim 1 or the claims that depend from it. Furthermore, Applicants submit that the Examiner’s generic definitions of “plastic” and “bonding” are moot in view of the amendments to claim 1.

Accordingly, Applicants respectfully request that the rejection of claim 1, and claims 2-8 and 11, which depend from it, be withdrawn and not extended to new dependent claims 12-18.

Claims 9 and 10 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as allegedly being obvious over Soltwedel et al. in light of the dictionary definitions cited in making the anticipation rejection. The Examiner asserts that claims 9 and 10 are product-by-process claims, and are therefore

anticipated by and/or obvious over the product according to the Soltwedel et al. reference. Applicants respectfully traverse this rejection for at least the following reasons.

Claims 9 and 10, as amended, recite “a decorative laminar coating” and a “substrate provided with a decorative coating,” respectively, obtained by the process of claim 1. Because claims 9 and 10 depend from claim 1, the coating that they recite would include a thermoplastic film bonded to the second coating layer with an adhesive.

Soltwedel et al., as was explained above, discloses a top coating composition formed of a material that is deposited in liquid form, not a thermoplastic film applied with an adhesive. Therefore, Applicants submit that the product of claims 9 and 10 would be structurally different from that suggested by Soltwedel et al. Moreover, Applicants submit that there is no disclosure or suggestion in Soltwedel et al. that a thermoplastic film could be adhesively bonded as the top coating layer in a coating composition.

Accordingly, Applicants respectfully submit that Soltwedel et al. does not anticipate or render obvious claims 9 and 10. Therefore, Applicants respectfully request that the rejection be withdrawn.

New Independent Claim 19

New independent claim 19 recites, in closed form, a coating composition consisting of, *inter alia*, “a thermoplastic film bonded to the electrophoretically deposited second coating layer with an adhesive.” As was explained above, Soltwedel et al. does not disclose or suggest a coating composition with that feature. Therefore, Applicants submit that the rejections in the November 22 Office Action should not be extended to claim 19.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached Appendix is captioned **"Version with markings to show changes made"**.

In view of the foregoing, this application is believed to be in condition for allowance. A timely Notice to that effect is respectfully requested. If questions relating to patentability remain, the Examiner is invited to contact the undersigned to discuss the same.

Respectfully submitted,

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Attachment: APPENDIX (p. 8)

**APPENDIX**

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**Claims 1, 9, and 10 are amended as follows:**

1. (Five Times Amended) A process for the production of a three-dimensional substrate provided with a protective and decorative laminar [structure] coating, comprising:

applying a primer layer of a coating composition which is electrically conductive in the stoved state without spraying onto an electrically conductive substrate and stoving said primer layer;

electrophoretically depositing a second coating layer of an electrophoretically depositable coating composition and stoving said second coating layer; and

bonding a thermoplastic film directly on the second coating layer using an adhesive [as] to form a third coating layer of the protective and decorative laminar [structure] coating;

wherein said [plastic] thermoplastic film, either alone or in conjunction with the second coating layer, determines the decorative effect of the laminar [structure] coating.

9. (Twice Amended) A decorative laminar [structure] coating obtained using the process of claim 1.

10. (Twice Amended) A three-dimensional substrate provided with a decorative laminar [structure] coating obtained according to claim 1.